

Serial No.: 09/652,284
Filed: 31 August 2000

PATENT
Attorney Docket No. A-70203/RMS/AXG/JML

REMARKS

In response to the outstanding restriction requirement, Applicant elects, with traverse, the claims of Group 1, namely, claims 1, 3, 5, 8-18, 20-30, 33-45, 6-7, 19, 31-32, 46-48, and 64-75 for further prosecution in this application. Pursuant to the provisions of 37 C.F.R. §§ 1.111 & 1.143, Applicant traverses the Examiner's requirement for restriction and requests reconsideration in light of the following remarks.

The Examiner's Restriction Fails to Comply with 35 U.S.C. §121

Applicant respectfully requests that this Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.41 and 1.142. 35 U.S.C. §121 provides that the Director may restrict an application when "two or more independent and distinct inventions are claimed in one application." Similarly, 37 C.F.R. §1.141(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application.

The Examiner argues that Groups I and II are unrelated and independent inventions, as the different inventions have different modes of operation in that the feature of a reference electrode of Group II is not required by Group I. The Examiner further suggests that Group I is drawn to an apparatus other than an electrode and Group II is drawn to an electrode.

Applicant respectfully submits that Groups I and II are not independent. M.P.E.P. §802.01 defines independent as follows:

The term "independent" (*i.e.*, not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect

The subject matter in Group I is directed toward an apparatus for electrical detection of molecular interactions between immobilized probe molecules and target molecules in a sample solution. Applicant respectfully disagrees with the Examiner's characterization of Group II as being drawn toward an electrode, and submits that Group II is directed toward the exact same apparatus as in Group I while employing a reference electrode, thereby also providing for electrochemical

detection of molecular interactions. Thus, Groups I and II differ only in that Group II carries the added limitation of a reference electrode.

Applicant respectfully submits that there is considerable overlap between the proposed groupings in that Group II recites a narrowed embodiment of the Group I apparatus. Accordingly, the subject matter in Groups I and II is very clearly interrelated and interdependent, and not "independent and distinct" as required by 35 U.S.C. §121 or M.P.E.P. §802.01. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

Different Classifications Are Not A Basis for Restricting Claims

The Examiner also suggests that the inventions have acquired a separate status in the art because of their recognized divergent subject matter, and the literature and structure search of group I is not required for group II, since group I is drawn to an apparatus other than an electrode and group II is drawn to an electrode. Applicant respectfully disagrees with the Examiner's characterization of Group II as being drawn to an electrode. Rather, Applicant submits that Group II is drawn to an apparatus comprising a substrate, containing all limitations of Group I and further reciting a reference electrode.

In any case, reliance on the classification of the groups of claims does not support the proposed restriction. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct; rather, the classification system is an aid in finding and searching for patents.

In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentee to make a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what

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they regard as their invention, regardless of the number of statutory classes involved. (Emphasis added.)

In re Kuehl, 456 F.2d 658, 666, 177 USPQ 250 (CCPA 1973).

III. Conclusion

Applicant respectfully requests reconsideration of the outstanding restriction requirement based on the foregoing remarks. Applicant encourages the Examiner to contact the undersigned with any questions or concerns.

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